

Group VIII: Claims 151-161.

On pages 7-10, the outstanding restriction requirement further requires that Applicants elect one of the following eighteen alleged species of the invention:

Species I: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for each transporting cycles of the load; means for transporting the product comprises a product row transporting system;”

Species II: the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for each transporting cycles of the load; means for transporting the product comprises a product layer transporting system;”

Species III: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for each transporting cycles of the load; means for transporting the product comprises a single product unit transporting system;”

Species IV: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for at least two transporting cycles of the load; means for transporting the product comprises a product row transporting system;”

Species V: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for at least two transportation cycles of the load; means for transporting the product comprises a product layer transporting system;”

Species VI: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for at least two transporting cycles of the load; means for transporting the product comprises a single product unit transporting system;”

Species VII: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for at least two transporting cycles of the load and executing a second logic sequence for a different transporting cycle while building the load; means for transporting the product comprises a product row transporting system;”

Species VIII: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for at least two transporting cycles of the load and executing a second logic sequence for a different transporting cycle while building the load; means for transporting the product comprises a product layer transporting system;”

Species IX: “the embodiment wherein the building of the load is based on a desired volume; executing a logic sequence for at least two transporting cycles of the load and executing a second logic sequence for a different transporting cycle while building the load; means for transporting the product comprises a single product unit transporting system;”

Species X: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for each transporting cycles of the load; means for transporting the product comprises a product row transporting system;”

Species XI: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for each transporting cycles of the load; means for transporting the product comprises a product layer transporting system;”

Species XII: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for each transporting cycles of the load; means for transporting the product comprises a single product unit transporting system;”

Species XIII: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for at least two transporting cycles of the load; means for transporting the product comprises a product row transporting system;”

Species XIV: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for at least two transporting cycles of the load; means for transporting the product comprises a product layer transporting system;”

Species XV: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for at least two transporting cycles of the load; means for transporting the product comprises a single product unit transporting system;”

Species XVI: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for at least two transporting cycles of the load and executing a second logic sequence for a different transporting cycle while building the load; means for transporting the product comprises a product row transporting system;”

Species XVII: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for at least two transporting cycles of the load and executing a second logic sequence for a different transporting cycle while building the load; means for transporting the product comprises a product layer transporting system;” and

Species XVIII: “the embodiment wherein the building of the load is based on a desired area; executing a logic sequence for at least two transporting cycles of the load and executing a second logic sequence for a different transporting cycle while building the load; means for transporting the product comprises a single product unit transporting system.”

Applicants provisionally elect to prosecute Group 1, claims 2-9, 15, 20, 21-23, 25-32, 38, 43-47, 49-58, 62, 65, 66, 68-79, 83, 86, 172, and 173. Applicants further provisionally elect to prosecute Species XIII. At least claims 25-32, 38, 43-47, 49-54, 62, 65, 66, 68-74, 83, 86, and 173 are directed to the species described in Species XIII. These elections are made with traverse for the reasons set forth in sections “A” and “B” below.

A. The Restriction Requirement is Improper:

On page 4 of the restriction requirement, the Examiner asserts that “[I]nventions I and II, I and III, II and III are related as subcombinations disclosed as usable together in a single combination.” On page 5 of the restriction requirement, the Examiner asserts that “[I]nventions V and VI, VI and VII, VI and VII are related as subcombinations disclosed as usable together in a single combination.” On page 6 of the restriction requirement, the Examiner asserts that “[I]nventions IV and I, II, III, VIII and V, VI, VII are related as combination and subcombination.” Applicants submit that the Examiner’s assertions are improper.

The M.P.E.P. provides the following explanations regarding the restriction of subcombinations usable together:

“Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually

restrictable when the subcombinations do not overlap in scope and are not obvious variants” (emphasis added). M.P.E.P. § 806.05(d).

“The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination” (emphasis added). M.P.E.P. § 806.05(d).

Applicants submit that Groups I, II, and III are not restrictable as subcombinations at least because they overlap in scope. See M.P.E.P. § 806.05(d). For example, claims 2-9, 15, and 20-23 of Group I; claims 10-13 and 16-19 of Group II; and claim 14 of Group III all depend either directly or indirectly from independent claim 1. Thus, each of those claims inherently includes the limitations of independent claim 1, and as such, they overlap in scope. Claims 25-32, 38, and 43-47 of Group I; claims 33-36 and 39-42 of Group II; and claim 37 of Group III all depend from independent claim 24, and thus, also overlap in scope. Similar reasoning can be applied to claims 49-58, 62, and 66 of Group I; claims 59, 60, 63, and 64 of Group II; and claim 61 of Group III with respect to independent claim 48. The same holds true for claims 68-79, 83 and 86 of Group I; claims 80, 81, 84, and 85 of Group II; and claim 82 of Group III with respect to independent claim 67. Thus, Groups I, II, and III overlap in scope, and are not restrictable in the manner proposed by the Examiner.

The Examiner also fails to show that one of the subcombinations has utility other than in the disclosed combination. See M.P.E.P. § 806.05(d). For example, with regard to Groups I, II, and III, the Examiner states on page 4 of the restriction requirement that, “subcombination I has separate utility such as for use in a load building system subcombination II has separate utility such as for use in a load building system [and] subcombination III has separate utility such as for use in a load building system.” Thus, it appears that the Examiner acknowledges that subcombinations or Groups I, II,

and II only have utility in the combination (i.e., in a load building system). As such, Groups I, II, and III are not restrictable in the manner proposed by the Examiner.

Groups V, VI, and VII are not restrictable as subcombinations because they also overlap in scope. See M.P.E.P. § 806.05(d). For example, claims 88-96, 102, and 107-112 of Group V; claims 97-100 and 103-106 of Group VI; and claim 101 of Group VII all depend either directly or indirectly from independent claim 87. Thus, each of those claims inherently includes the limitations of independent claim 87, and as such, they overlap in scope. Claims 114-119, 125, and 130-134 of Group V; claims 120-123 and 126-129 of Group VI; and claim 124 of Group VII all depend from independent claim 113, and thus, also overlap in scope. Similar reasoning can be applied to claims 136-141, 145, and 148-150 of Group V; claims 142, 143, 146, and 147 of Group VI; and claim 144 of Group VII with respect to independent claim 135. Thus, Groups V, VI, and VII overlap in scope, and are not restrictable in the manner proposed by the Examiner.

As to Groups V, VI and VII, the Examiner also fails to show that one of the subcombinations has utility other than in the disclosed combination. See M.P.E.P. § 806.05(d). On page 5 of the restriction requirement, the Examiner states that, "subcombination V has separate utility such as for use in a load building system subcombination VI has separate utility such as for use in a load building system [and] subcombination VII has separate utility such as for use in a load building system." Thus, it appears that the Examiner acknowledges that subcombinations or Groups V, VI, and VII only have utility in the combination (i.e., in a load building system). As such, Groups V, VI and VII are not restrictable in the manner proposed by the Examiner.

As to the Examiner's assertion, on page 6 of the restriction requirement, that "[I]nventions IV and I, II, III, VIII and V, VI, VII are related as combination and subcombination." The M.P.E.P. recites, "[a] combination is an organization of which a subcombination or element is a part." M.P.E.P. § 806.05(a). The restriction requirement fails to identify which of the alleged different inventions constitutes the combination, and which constitutes the subcombination, leaving it unclear as to how Groups IV and I, II, III, VIII and V, VI, VII are related as combination and subcombination. If the Examiner maintains this restriction, Applicants request that the Examiner clarify as to which of the Groups constitute the combination, and which constitute the subcombinations. Upon clarification, Applicants request that the Examiner also provide an explanation of how the proposed restriction fulfills the requirements of M.P.E.P. § 806.05(c).

B. The Election of Species Requirement is Improper:

An election of species requirement is proper if an application includes claims directed to different embodiments or species that could fall within the scope of a generic claim and the species are independent or distinct. See M.P.E.P. § 806.04. However, the M.P.E.P. also explains when an election of species requirement is improper, as provided below.

"Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of the invention, restriction therebetween should never be required. This is because the claims are not directed to distinct invention; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition." M.P.E.P. § 806.03.

"Claims are definitions of inventions. *Claims are never species*. The scope of a claim may be limited to a single disclosed embodiment (i.e., a single species, and thus be designated a *specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth and scope of the claim (and

thus be designated a *generic or genus claim*). *Species are always the specifically different embodiments*. M.P.E.P. § 806.04(e).

Applicants submit that the election of species requirement on pages 7-10 of the restriction requirement is improper, at least because claims 1-171 describe similar characteristics of a single disclosed embodiment of a method and system. More particularly, the present application is directed to a method and system for building a load and, in describing the system, relies upon illustrations of the method and system shown in FIGS. 1-11. FIGS. 1-11 show different views and/or focus on different aspects of the method and system, but nevertheless, Applicants respectfully assert that a single exemplary embodiment is disclosed, and that claims 1-171 are different definitions of the same disclosed subject matter. As such, it appears that the primary reason for the election of species is based on the varying breadth of the claims and not on the presence of different embodiments or species of the invention. This practice is explicitly prohibited by M.P.E.P. § 806.03 (see above).

Typically, an election of species requirement separates the species based on separate figures. This practice is seemingly consistent with M.P.E.P. § 806.04(f), which requires that the disclosed species be mutually exclusive. Because FIGS. 1-11 of the present application do not illustrate mutually exclusive species and thus could not support such an election of species requirement, the Examiner apparently attempted to make an election of species requirement by separating claims and grouping them by claimed elements. For example, in the restriction requirement, Species I-VI recite limitations in claims 1, 15, and 23; Species VII-IX recite limitations in independent claim 172; Species X-XV recite limitations in claims 24, 38, and 47-49; and Species XVI-XVIII recite limitations in independent claim 173.

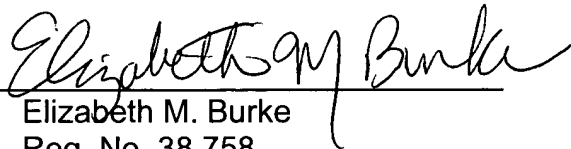
However, Applicants are permitted to describe their invention in claims of varying breadth, i.e., to set forth claims that include different combinations of elements. See e.g., M.P.E.P. § 806.03 (noting that claims are "different definitions of the same disclosed subject matter, varying in breadth or scope of definition"). Thus, the fact that certain claims include limitations that may not be found in other claims is insufficient grounds for making an election of species requirement. As noted above, claims are never species but are definitions of the invention. See M.P.E.P. § 806.04(e). Applicants respectfully submit that the grouping of claim limitations into the alleged species improperly characterizes claims of varying breadth into distinct species, which is explicitly prohibited by M.P.E.P. § 806.04(e). Thus, the election of species requirement is improper and should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Elizabeth M. Burke
Reg. No. 38,758